

REMARKS

Applicants would originally like to thank the Examiner for consideration of the references in Applicants' Information Disclosure Statement as evidenced by the checked box for Attachment (3) on the summary sheet of the Office Action. However, Applicant's copy of the Office Action as received by counsel did not include the attached signed PTO-Form 1449. The deficiency was identified in the prior response under 37 CFR 1.111, but the signed form has not been provided. Applicants ask the Examiner to include a copy of the signed 1449 with the next official communication.

Claims 13, 15-19, 21-24, and 26-30 have been rejected under 35 U.S.C. § 103 as obvious over Horrер in view of Young. Claims 14 and 20 have been rejected under 35 U.S.C. § 103 as obvious over Horrер in view of Young and Chambers. Claim 25 has been rejected under 35 U.S.C. § 102 as anticipated by Horrер.

By the present amendment, claims 13-30 remain in the application. No claims have been amended or added.

The Examiner has rejected claim 13 as obvious over Horrер in view of Young. The Examiner's rejection is respectfully traversed.

In Horrер, a system is provided such that an incoming phone call can be "rerouted" to a special call number aboard an aircraft. Horrер does not disclose the specifics as to how this is done. As pointed out by the Examiner, there is no disclosure or suggestion in Horrер to set the user's telephone to busy regardless of its actual state, and therefore no disclosure or suggestion to redirect incoming calls based on such disclosure instructions.

Young does not provide what is missing from Horrер. In Young, a "busy" state is indicated if the called terminal cannot form a connection with the supporting network (*see, e.g.,*

column 14, lines 36-44). To the extent that this is considered “busy” regardless of the actual state of the telephone, then such a busy state has nothing to do with redirection of calls or access of divert on busy instructions. It provide no suggestion or motivation to modify the teachings of Horrer in the manner that the Examiner proposes.

Other portions of Young related to “busy” states involve situations in which the network is overloaded such that the system responds that “all lines are busy”. (*See, e.g.*, the Examiner’s citations to column 16, lines 7-12 and column 17, lines 5-10). Lines being busy because the network is overloaded has nothing to do with the state of the individual phones, and a telephone is not considered “busy” under these circumstances. A caller would not hear a busy signal, nor would the call be redirected per Horrer.

Accordingly, there is no teaching or suggestion in the references themselves which would lead to the combination as put forth by the Examiner.

Absent such specific suggestion, the Examiner states that such suggestion is nonetheless present because the combination “would allow for improved communications between a ground station and a cellular station located on a moving object.” The Examiner’s analysis places the cart before the horse. The issue is whether there is suggestion to combine teachings of the references *in the first place*. Here, the Examiner finds suggestion out of the benefits achieved *after the combination is assembled*. This latter approach is impermissible hindsight which cannot be used to combine references.

Indeed, the generalized suggestion set forth by the Examiner is too broad to support any specific combination of reference. Per the Examiner’s purported suggestion, any proposed invention in this art would be obvious if the teachings were found in two references and the combination would result in improved communication between two points. Under such a broad

net, nothing could ever be patented in this field. As a practical matter, calling upon such an overbroad basis for suggestion to combine effectively -- and improperly -- eliminates the requirement of suggestion.

Accordingly, the combination of elements in claim 13 is neither taught nor suggested by the applied art. Withdrawal of the rejection of claim 13 and allowance of the same is therefore respectfully requested.

The Examiner has also rejected claims 15-19, 21-24, and 26-30 under 35 U.S.C. § 103 as obvious over Horrер in view of Young. For at least the reasons advanced in favor of claim 13, the other noted claims are also patentably distinct over this applied art. Withdrawal of the rejection and allowance of the same is therefore respectfully requested.

Claims 14 and 20 have been rejected under 35 U.S.C. § 103 as obvious over Horrер in view of Young and Chambers. Chambers does not provide the teaching or suggestion that is lacking in Horrер and Young as set forth above. For at least the reasons advanced in favor of claim 13, claims 14 and 20 are also patentably distinct over this applied art. Withdrawal of the rejection and allowance of the same is therefore respectfully requested.

Claim 25 has been rejected under 35 U.S.C. § 102 as anticipated by Horrер. The Examiner's rejection is respectfully traversed. In order for a reference to anticipate an invention, then each and every limitation as set forth in the claim must be present in the identified reference. If so much as a single reference is not so anticipated, then the rejection may not be properly maintained.

Claim 25 recites receiving, from the cellular telephone aboard the aircraft, user data associated with the cellular telephone having an associated cellular telephone number. Claim 25 also recites sending, from the aircraft, at least the user data and the temporary identification code.

The Horrer reference does not disclose any such activities in connection with the aircraft. Disclosure of forwarding the receipt of incoming calls to an aircraft does not translate into teaching of these events taking place aboard the aircraft. Absent such teaching, the rejection for anticipation may not be properly maintained. With respect to suggestion, there is also no teaching of the same, or indication as to how this would be done.

Accordingly, claim 25 is patentably distinct over the applied art. Withdrawal of the rejection and allowance of the same is therefore respectfully requested.

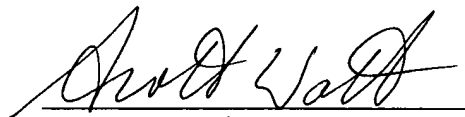
In view of the foregoing, the application is now believed to be in condition for allowance. A notice to that effect is earnestly solicited.

If a telephone conference would be of value, the Examiner is requested to call the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge/credit any fee deficiencies/overpayments to Deposit Account No. 19-4293.

Should there be any questions, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Scott D. Watkins', is written over a horizontal line.

Scott D. Watkins
Reg. No. 36,715

Date: December 6, 2004

Steptoe & Johnson LLP
1330 Conn. Ave., N.W.
Washington, DC 20036
(202) 429-6439